

OK TO ENTER: /K.B./

/Kelly Bekker/

03/23/2009

**EXPEDITED HANDLING PROCEDURE  
PURSUANT TO 37 C.F.R. § 1.116**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/620,038

Applicant : Shimek et al.

Filed : July 15, 2003

Title : Soft Dried Marshmallow and Method of Preparation

TC/A.U. : 1794

Examiner : Bekker, Kelly Jo

Docket No. : 6126US

**BOX AF**  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**RESPONSE AFTER FINAL**

Sir:

This paper is filed in response to the Office Action dated January 12, 2009 issued in the above-identified U.S. patent application. In view of the following remarks, reconsideration of the application is respectfully requested.

Remarks/Arguments begin on page 2 of this paper.

**REMARKS/ARGUMENTS**

Initially, Applicant notes with appreciation that the Examiner has withdrawn all the rejections under § 112, second paragraph of claims 30 and 31. Currently, claims 1, 3-27, 29-39 and 81 remain pending.

Claims 1, 3-9, 14, 15, 32, 38 and 81 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Roy et al. (U.S. Patent Application Publication No. 2004/0109933). Generally, the Examiner appears to be of the opinion that Example 1 of Roy et al. teaches a final product which comprises .1% water, 89.22% of a sucralose solution and 5.7 of a gelatin solution and teaches in paragraph 10 that glycerin alone can be substituted for dextrose alone, resulting in Roy et al. teaching about 11% glycerin. The Examiner further argues that Roy et al. inherently teaches a product that has a glass transition temperature and a springback factor that corresponds to the present invention. According to the Examiner, where the claimed and prior art products are substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. The Examiner relies on *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) and *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). This rejection is respectfully traversed.

The Applicant will admit that the Examiner is correct to the extent that an inherent feature can be relied upon for an anticipatory rejection. As set forth in M.P.E.P. 2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” However, as recognized by the Examiner, it is only when the identical product is in the prior art and in the claim that inherent features may be presumed and a *prima facie* case established. The fact that a prior art article or product may inherently have the characteristics of the claimed product is not sufficient for anticipation. See *Ex parte Skinner* 2 USPQ 2d 1788 (BPAI 1986). Rather, inherency must be a necessarily result and not merely a possible result (*In re OIre* 666 Fed. 2d 578, 212 USPQ 323 (See CCPA 1991)). The prior art

reference of Roy et al. is directed to an aerated confection which has a high level of fruit solids and preferably includes a stiffening agent of hexametaphosphate. At the very least, if the other ingredients of Roy et al. are similar to those claimed, the addition of a high level of fruit solids and a stiffening agent should at least indicate that the two compositions are not identical. Therefore, the Examiner cannot presume that the composition in Roy et al has certain ingredients of the claimed invention, and then ignore the fruit solids and stiffeners especially because there is no teaching or suggestion in the prior art to remove these ingredients. Roy et al. is not an anticipating reference because, simply stated, Roy et al. does not teach or suggest at least a soft dried marshmallow having a glass transition temperature or springback factor as claimed.

Furthermore, the Roy et al. reference should be removed from consideration because of the two affidavits previously submitted under 37 C.F.R. 1.131 which establish a reduction of practice of the invention prior to the effective October 31, 2003 date of Roy et al. The Examiner has not accepted the affidavits and accompanying evidence because, according to the Examiner, the affidavit does not establish a possession of the whole invention as claimed or something falling within the claim such as a species of the claimed genus. The Examiner refers to the affidavit showing a marbit that was reduced to practice with a water activity of 0.25 comprising both glycerin and fat, wherein the glycerin, a softening agent, is included at a maximum of 15%. According the Examiner, the affidavit does not include a marbit that does not require fat and that comprises .05 – 15% foaming agent, 0.5-20% structuring agent, moisture content of 1-10%, and water activity of .1-.5 and/or 5-25% of a softening agent as instantly claimed. The Applicant respectfully traverses this position. Currently, claim 1 can include fat since the claim is open ended by using the transitional word “comprising.” It is not until claim 9 that the amount of fat is limited to less than 5%. Therefore, it is unclear why the Examiner indicates the affidavit must show an example without fat. The water activity as claimed is ranging from about .1 to about .4. The Examiner appears to allege that the water activity of the disclosed marbit is .25. Actually, the affidavit references marbits between .101 and .171, while referencing that the cereal can have a water activity of .25.

Referring specifically to batch 33-44, a marbit is shown having a sugar slurry and a hydrogenated gelatin. The sugar slurry includes sugar, corn syrup, dextrose and water, while the hydrogen gelatin includes gelatin. Corn syrup is added at an optimum level of about 10%. It is interesting to note that the Examiner considers from example 1 in Roy et al. that comprises .1% water, 89.22% of the sucralose solution and 5.7% of a gelatin solution which may contain 11% glycerin to read on claim 1, yet is of the opinion that the composition disclosed in the affidavit does not. Respectfully, Applicant submits that the evidence produced is sufficient to prove reduction to practice before the critical date such that Roy et al. is not effective prior art.

The Examiner has further rejected claims 10-13, 19, 20, 22, 27, 29-31 and 81 under 35 U.S.C. 103(a) as being unpatentable over Roy et al. in view of U.S. Patent No. 6,309,686 to Zietlow; claims 16-18, 21, 23, 25, 26 and 33 as being unpatentable over Roy et al. in view of U.S. Patent No. 6,207,216 to Zietlow; claims 34 and 35 as being unpatentable over Roy et al. in view of '216 to Zietlow and Igoe; and claims 37 and 39 as being unpatentable over Roy et al. in view of '216 to Zietlow, Igoe and U.S. Patent No. 4,251,561 to Gajewski. Again, the submitted §1.131 affidavits effectively remove Roy et al. as prior art. Regardless, the Applicant continues to maintain that the Examiner has failed to establish a *prima facie* case of obviousness in rejecting these claims. More specifically, Roy et al. does not teach the glass transition temperature or the springback factor required in claim 1. In fact, none of the cited references teach the glass transition temperature or springback factor of the present invention. Further, '216 to Zietlow et al. is directed to a dried, **crisp, frangibile** marshmallow, which clearly teaches away from a dried soft marshmallow having a softening agent sufficient to provide a **glass transition temperature of less than 5° C or the recited springback factor**, as is required by the present invention.

Based on the above remarks, the Applicant respectfully submits that the present invention is patentably defined over the prior art of record such that allowance of all claims and passage of the application to issue are respectfully requested. If the Examiner

should have any additional questions or concerns regarding this matter, she is cordially invited to contact the undersigned at the number provided below in order to further prosecution.

Respectfully submitted,



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Date: March 19, 2009  
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